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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,922	06/26/2001	Bret P. O'Rourke	MS1-656US	3848
22801	7590	12/08/2004	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				AL HASHEMI, SANA A
ART UNIT		PAPER NUMBER		
		2161		

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/892,922	O'ROURKE ET AL.
	<b>Examiner</b> Sana Al-Hashemi	<b>Art Unit</b> 2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 July 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/21/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

1. Claim Status: 1-34 are rejected.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 21, 2004 has been entered.

Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1- 34 are drawn to a search database and providing responses passed on the user request, classified in class 707, subclass 3.
- II. Claims 35-67 are drawn to combining and maintaining play list stored on a server, classified in class 707, subclass 102.

Inventions I and II are related as combination and subcombination respectively.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particular subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (I) as claimed (i.e. in response to a user request the server provides specific modified information) does not require the method of combining and maintaining a play

list of streaming media content items as claimed in subcombination (II). Subcombination (II), i.e. the method combining streaming media content and maintaining a play list as claimed has separate utility by itself or in other combinations such as web crawlers, and does not require the particular combination as claimed in combination (I) of a providing modified data structure based on a user request for patentability. Therefore, the inventions are distinct; however, they could be usable together.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for I is not required for II, respectively, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. A telephone call was made to Brian G. Hart on December 1, 2004, to request an oral election to the above restriction requirement, which results in an election being made. Applicant's election made without traverse of claims 1-34.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Reilly et al. (US Patent 5,740,549).

Regarding Claims 1, 10, 17, and 24, Reilly discloses a method for a server to provide content to a client, the method comprising:

receiving a request from the client for one or more requested content items (see column 8, lines 19-24, Reilly);

identifying a data structure that refers to one or more further content items (see column 7, lines 50-58, Reilly) ;

modifying, by the server computer, a data structure that refers to one or more further content items (see column 8, lines 19-29, Reilly); and

providing the content items referenced by the modified data structure (see column 8, lines 5-15, Reilly);

Regarding Claims 2, 11, 18, and 25, Reilly discloses a method wherein identifying the data structure, the data structure comprises a playlist (see column 7, lines 7-12, Reilly<sup>1</sup>); wherein receiving the request, the one or more requested content items comprises streaming media content (see column 4, lines 21-38, where as Reilly's "news feed from information transmission... AP news feed ...", is equivalent to applicant use of the phrase "streaming media", both are used to transmit data in a continues fashion, Reilly); and wherein providing the content items further comprises streaming the content items referred to by the playlist (see column 4, lines 39-49, Reilly).

Regarding Claims 3, 12, 19, and 26, Reilly discloses a method wherein identifying the data structure, the data structure comprises a first Web page specification, and the requested content comprises a second Web page specification (see column 6, lines 1-9, Reilly).

Regarding Claims 4, 13, 20, and 27, Reilly discloses a method wherein modifying the data structure further comprises adding a plurality of references to the requested content item in the data structure (see column 4, lines 39-39, Reilly).

Regarding Claims 5, 14, 21, and 28, Reilly discloses a method wherein modifying the data structure further comprises adding a plural number of references to the requested content item in the data structure, the number being indicated by the request (see column 4, lines 39-39, Reilly).

Regarding Claims 6, 15, and 22, Reilly discloses a method wherein receiving the request, further comprises receiving a variety of requests from the client, at least one subset of the variety

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<sup>1</sup> Examiner interprets the category and sub category corresponds to a play list)

of requests comprising respective requests to one or more different content items (see column 4, lines 50-65, Reilly).

Regarding Claims 7, 16, and 23, Reilly discloses a method wherein modifying the data structure, the data structure further comprises a placeholder that identifies a particular point in a sequence where the reference to the requested content is placed (see column 4, and 5, lines 66-67, and 1-7, respectively, Reilly<sup>2</sup>).

Regarding Claims 8, and 29, Reilly discloses a method wherein identifying the data structure further comprises creating the data structure by modifying a base data structure (see column 6, lines 46-56, Reilly).

Regarding Claims 9, and 30, Reilly discloses a method wherein identifying the data structure further comprises creating the data structure copying a base data structure (see column 10, lines 10-18, Reilly).

Regarding Claim 31, Reilly discloses sever wherein at least a subset of the received request refer to differing content items (see column 7, lines 7-12, Reilly).

Regarding Claim 32, Reilly discloses a computer-readable medium having stored thereon a wrapper data structure comprising:

one or more first data fields, each data field containing data therein representing a respective reference to a set of content items (see Fig. 8, Category queue headers, Reilly) ; and  
at least one second data field containing data therein representing a respective placeholder to identify a particular point in a sequence of the one or more first data fields where

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<sup>2</sup> Examiner interprets the step of identifying a category corresponds to a place holder.

a reference to a set of client requested content is to be inserted (see Fig 8, Advertisement queue, and News story queue, Reilly).

Regarding Claim 33, Reilly discloses a computer-readable medium:

wherein the data structure comprises a playlist (see Fig. 5, 222, Reilly); and

wherein the content items and the client requested content are streaming media content items that are respectively identified with a Universal Resource Locator (see Fig. 2, 211, Reilly).

Regarding Claim 34, Reilly discloses a computer-readable medium:

wherein the data structure comprises a Web page(see column 13, lines 9-14, Reilly);

wherein the content items are a first set of Web page specifications (see column 13, lines 15-20, Reilly); and

wherein the client requested content are one or more second Web page specifications (see column 13, lines 20-25, Reilly).

*Points of Contact*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to: Sana Al-Hashemi whose telephone number is (571) 272-4013. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahić, can be reached on (571) 272-4023. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 746-7416. For formal or draft communications, please label "PROPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

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Sana Al-Hashemi  
Patent Examiner  
Technology Center 2100  
December 3, 2004



ALFORD KINDRED  
PRIMARY EXAMINER